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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number 08/465,322

Filing Date 5 June 1995

First Named Inventor SODERLUND, Hans E.

Art Unit 1634

Examiner Name MYERS, Carla J.

Total Number of Pages in This Submission

Attorney Docket Number 13025-4

ENCLOSURES (Check all that apply)

☐ Fee Transmittal Form

☐ Fee Attached

☐ Amendment/Reply

☐ After Final

☐ Affidavits/declaration(s)

☐ Extension of Time Request

☐ Express Abandonment Request

☐ Information Disclosure Statement

☐ Certified Copy of Priority Document(s)

☐ Response to Missing Parts/
Incomplete Application

☐ Response to Missing Parts
under 37 CFR 1.52 or 1.53

☐ Drawing(s)

☐ Licensing-related Papers

☐ Petition

☐ Petition to Convert to a
Provisional Application

☐ Power of Attorney, Revocation
Change of Correspondence Address

☐ Terminal Disclaimer

☐ Request for Refund

☐ CD, Number of CD(s) _____

Remarks

☐ After Allowance communication
to Technology Center (TC)

☐ Appeal Communication to Board
of Appeals and Interferences

☐ Appeal Communication to TC
(Appeal Notice, Brief, Reply Brief)

☐ Proprietary Information

☐ Status Letter

☒ Other Enclosure(s) (please
Identify below):

Reply to a Non-Compliant Amendment under
37 CFR 1.121

Receipt Acknowledgement Postcard

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm
or
Individual name

J. David Ellett, Jr.

Signature

Date

19 April 2004

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Date

19 April 2004

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Attorney Docket 13025-4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Applicants:	SODERLUND, Hans E. and SYVANEN, Anne-Christine)	Examiner: MYERS, Carla J.
Serial No.:	08/465,322)	Group Art Unit: 1634
Filed:	5 June 1995)	
For:	"Reagent Kit for Determining Specific Nucleotide Variations ")	

Kalow & Springut LLP
488 Madison Avenue, 19th Floor
New York, New York 10022

19 April 2004

Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

**REPLY TO A NOTICE OF NON-COMPLIANT
AMENDMENT UNDER 37 CFR 1.121**

SIR or MADAM:

This is in reply to a notice of non-complaint amendment issued on 17 March 2004 with respect to a reply to a final office action filed on 11 March 2004 with a request for continued examination (RCE) in connection with the patent application identified above. The time set for a reply to the notice of non-complaint amendment was 17 April 2004, a Saturday. The present

Certificate of Mailing Under 37 CFR 1.8

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19 April 2004
Date

J. David Ellett, Jr.
J. David Ellett, Jr. (Reg. No. 27,875)

Applicants: Soderlund, Hans E., and Syvanen, Anne-Christine
Filing Date: 5 June 1995
Serial No.: 08/465,322
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reply is being submitted to the Patent and Trademark Office by mail with a certificate of mailing on 19 April 2004, the next business day following the day set for a reply.

In the outstanding notice of non-complaint amendment, it was asserted that the reply of 11 March 2004 failed to meet certain requirements of 37 CFR 1.121. In particular, it was asserted that the amendments to the claims in the reply of 11 March 2004 did not include a complete listing of all of the claims and that the claims of the reply had not been presented in ascending numerical order. The notice of non-complaint amendment required that only corrected sections of the assertedly non-complaint amendment document be resubmitted in their entirety.

The attorneys for the applicants respectfully submit that the amendments to the claims in the reply of 11 March 2004 fully complied with 37 CFR 1.121. In particular, 37 CFR 1.121(c) specifies that “[e]ach amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application.” [Underlining added.] As pointed out in the section of the reply of 11 March 2004 involving amendments to the claims of the subject application, the subject application was a continued prosecution application (CPA) which was filed on 5 April 2002 with a preliminary amendment. The listing of claims in the section of the reply of 11 March 2004 involving amendments to the claims was an accurate listing of all the claims of the subject continued prosecution application filed on 5 April 2002. Furthermore, following the first claim listed in the amendments-to-the-claims section of the reply of 11 March 2004 – claim 51 – each succeeding claim listed was numbered with a number which was numerically greater than the number of the preceeding listed claim, so that the claims were presented in a mathematically ascending numerical order, as called for in 37 CFR 1.121(c)(1).

In a telephone conference with the undersigned attorney on 1 April 2004, attorney Robert J. Spar of the Office of Patent Legal Administration of the Patent and Trademark Office

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indicated that, notwithstanding the language in 37 CFR 1.121(c) calling for a complete listing of all claims "in the application" and the fact that a continued prosecution application (CPA) is a separate application from the parent application on which the continued prosecution application is based, the Patent and Trademark Office expected a continued prosecution application and its immediate parent application to be treated as a single application for purposes of compliance with the requirements of 37 CFR 1.121(c).

Although the attorneys for the applicants maintain that the claim listing in the amendments-to-the-claims section of the reply of 11 March 2004 was fully compliant with the express wording of 37 CFR 1.121(c) and that the objections to the reply set out in the notice of non-compliant amendment of 17 March 2004 were without merit, to expedite prosecution of the subject application, an alternative amendments-to-the-claims section for the reply of 11 March 2004 is set out below which ignores the distinction between the subject continued prosecution application (CPA) filed 5 April 2002 and its immediate parent application of the same application number filed on 5 June 1995. In addition, in accordance with a suggestion of an associate of attorney Spar given to the undersigned attorney in a telephone conference on 1 April 2004, the listing set out below of the claims of the subject continued prosecution application and its immediate parent application does not indicate a renumbering of original claims 47 to 75 inclusive to 40 to 68 inclusive provided in an Office Action dated 16 May 1997 in connection with the immediate parent of the subject continued prosecution application.

Authorization is hereby given to the Patent and Trademark Office to enter in the file of the subject application, at the Office's election, the alternative amendments-to-the-claims section for the reply of 11 March 2004 set out below which ignores the distinction between the subject continued prosecution application (CPA) and its immediate parent as a replacement for the amendments-to-the-claims section of the reply of 11 March 2004 as originally filed which, it is respectfully submitted, properly took account of the distinction between the subject continued prosecution application and its immediate parent.